

Application No.: 10/627,144
Reply to Office Action mailed January 22, 2007

Docket No.: 83,684

REMARKS

Claims 1-6 and 15-19 are pending in this application. Claims 7-14 have been previously cancelled. The application has been carefully reviewed in light of the Office Action mailed on January 22, 2007. Reconsideration of all outstanding rejections in view of the following remarks is respectfully requested.

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barnes (US Patent No. 5,970,475) in view of Howard (U.S. Patent No. 6,768,994) and further in view of Rosenfeld (U.S. Patent No. 6,901,377).

Barnes, Howard and Rosenfeld do not disclose each element of the combinations recited in claims 1-6. For example, claim 1 recites, *inter alia*, "a method for collecting, accessing, manipulating, and selectively displaying data, said method comprising the steps of ... collecting data relating to ... task funding" The Office Action on page 9 acknowledges that Barnes does not disclose "task funding", but contends that Rosenfeld at Col. 5, lines 38-40 discloses "task funding". In fact, Rosenfeld actually discloses "cost estimates".

The Office Action further states that it would have been obvious to incorporate the teachings of Rosenfeld and Howard into Barnes because it has historically been difficult for manufacturers to provide services for their clients citing Rosenfeld, Col. 1, lines 16-17. The Office Action further contends the argued modification of Barnes, Howard and Rosenfeld is obvious due to "large companies [sometimes having] employees handling the ordering of parts or handling the repair and warranty process, and the overhead associated with not having a centralized database [costing] millions of dollars a year" citing Barnes Col. 1, lines 48-51. Applicant respectfully submits that the Office Action's proposed suggestion, teaching or motivation to combine does not provide an "apparent reason to combine the known elements in the fashion claimed by the patent in issue" and therefore lacks sufficient suggestive power to support a conclusion of obviousness.

As noted in the Office Action at page 2, the basis for all obviousness rejections is 35 U.S.C. § 103 which provides that "a patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between

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the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The Office Action further states that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a). In *John Deere*, the Supreme Court described four factors that are relevant to a determination of obviousness: (1) the scope and content of the prior art; (2) the skill level of a person of ordinary skill in the art; (3) the differences between the claimed invention and the prior art's teachings; and (4) any objective indications of obviousness or non-obviousness, such as the commercial success of the invention.

The Supreme Court recently further explained and clarified the *John Deere* decision in *KSR International v. Teleflex Inc.*, U.S. Supreme Court No. 04-1950 (April 30, 2007). The *KSR* Court conceded that application of these principles may be difficult in some cases "because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement." (*KSR*, Slip Op. at 13-14.) The *KSR* Court explained that "[o]ften, it will be necessary for a court to ... determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." (*KSR* Slip Op. at 14.)

MPEP § 2143 sets forth the requirements to be shown by the Examiner in order to have successfully established a prima facie case of obviousness. As stated therein, to establish a case of prima facie obviousness: i) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, ii) there must be a reasonable expectation of success, and iii) the prior art reference (or references when combined) must teach or suggest all the claim limitations. Moreover, MPEP § 2143.01 states that some additional objective reason to combine the teachings of references must be shown by the Examiner. That is, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 quoting *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

No such teaching, suggestion or motivation is present in the cited references. Without

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using the present claims as a roadmap, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references. The rejections are based on an impermissible hindsight reconstruction of the present invention from the cited references that is not based on an "apparent reason to combine the known elements in the fashion claimed by the patent at issue." See *KSR* Slip Op. at 14; See also *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. App. 1985) (requiring "convincing line of reasoning" to support obviousness determination). The fact that the present invention was made by the Applicant does not make the present invention obvious; that suggestion or teaching must come from the prior art. See *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1940, 1952 (Fed. Cir. 1998). See e.g. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 897 F.2d 1044, 1051 (Fed. Cir. 1988) (It is impermissible to reconstruct the claimed invention from selected prior art absent some suggestion, teaching or motivation in the prior art to do so).

Even assuming for argument's sake that the Office Action is correct in stating all elements of the claims are present in Barnes, Howard and Rosenfeld, there is not an "apparent reason" to combine the references in the manner suggested by the Office Action. The suggestive power of the references must be weighed and used to determine whether there is an adequate or apparent suggestion or motivation to combine the references to reach a claimed combination. See *KSR* and MPEP 2149.01, Suggestion or Motivation to Modify the References. The reason offered by the Office Action refer to the most general and vague motivations of difficulty of providing services for clients, a statement that large companies have employees handling repair and warranty processes and costly overhead associated with a failure to have a centralized data base.

Mirriam-Webster's online dictionary defines the term "apparent" as "1: open to view : VISIBLE; 2: clear or manifest to the understanding <reasons that are readily apparent>; 3 : appearing as actual to the eye or mind; 4 : having an indefeasible right to succeed to a title or estate; 5 : manifest to the senses or mind as real or true" (See <http://www.mirriamwebster.com/dictionary/apparent>) In this case, the general reasons cited by the Office Action to not rise to the level of an "apparent", clear or manifest reason to combine the elements of claim 1. Moreover, common sense tells us that a vague general suggestion or motivation is not likely to motivate a person skilled in the art of an invention to search out specific references or to motivate them to combine multiple references in the manner suggested by the Office Action. The suggestive power of the Office Action's motivations to combine the three

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references to reach the claimed invention is weak and tenuous at best therefore does not rise to the level of required evidence to meet either the threshold for obviousness or the "substantial evidence" standard of review under the Administrative Procedures Act (APA). As noted In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), the standard of review under the APA for a finding by the USPTO is "concrete evidence in the record in support of these findings." In fact, logic and basic mathematics regarding combinational and permutations tells us that the more references that are sought to be combined, the less of a probability that such a combination would in fact occur. As the degree of generality of the references increases, the probability that a person skilled in the art would in fact reach the claimed invention so decreases. Accordingly, the proposed generic motivations do not reach the level of "concrete evidence" with a sufficient nexus or suggestive power between the claimed combination and the Office Action's findings.

Accordingly, for the above and other reasons, claim 1 is allowable over Rosenfeld, Barnes and Howard.

Claims 2-5 depend from claim 1, thus are allowable for the above and other reasons.

In another example, claim 6 recites, *inter alia*, "a system for collecting, storing, querying, and maintaining data, said system comprising ... means for collecting data that characterizes ... funding" For the same reasons as noted above, none of the cited references disclose "funding" Accordingly, claim 6 is allowable over the cited references for at least the foregoing reasons.

Claims 15 through 19 depend from claim 6, directly or indirectly, thus are allowable along with claim 6 and for other reasons.

For at least these reasons the Office Action fails to establish a *prima facie* case of obviousness and withdrawal of the rejection of claims 1-6 and 15-19 is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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